

Serial No.: 10/065,282  
Attorney Docket No.: F-522

Patent

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**REMARKS****1. Status of Claims**

Claims 1-17 were pending in the Application. Applicants have amended claims 1 and 15 and cancelled claim 4 without prejudice or disclaimer. Applicants have added new claims 21-24 wherein claim 21 corresponds to previously claim 4 written in independent form that was indicated as allowable subject matter. Applicants respectfully request entry of the above amendments and consideration of the enclosed remarks. Applicants submit that no new matter is added. Accordingly, claims 1-3, 5-17 and 21-24 will remain pending in the application.

**2. Rejections under 35 USC § 103(a)**

In section 2 of the Office Action, the Examiner rejected Claims 1-3 and 5-17 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,681,045 B1 to Lapstun, et al. ("Lapstun '045") in view U.S. Patent No. 6,941,510 to Ozzie, et al. ("Ozzie '510").

Applicants respectfully traverse the rejection and note that Ozzie '510 describes general purpose computer memory and one of skill in the art would not look to Ozzie '510 to modify Lapstun '045 as nothing in either reference suggests attaching a dynamic read-write storage device to a document.

However, solely in order to expedite prosecution, Applicants have amended claims 1 and 15 and the rejection is moot.

Regarding claim 1, Applicants respectfully submit that at least the following elements are not taught or suggested by the cited references:

wherein the digital pen is utilized to facilitate storing the processed metadata in the dynamic read-write storage device.

Furthermore, regarding claim 3, Applicants respectfully resubmit that the references do not teach or suggest:

wherein the metadata includes a character representation of the captured pen stroke metadata and wherein the metadata storage device is attached to the predefined area of the document.

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The cited portions of Lapstun '045 appear to suggest applying color palette selections to pen strokes, but do not teach or suggest metadata comprising character text versions of the pen strokes.

Regarding claim 7, Applicants respectfully submit that Lapstun '045 does not teach or suggest storing biometric metadata on the document.

The cited portions of Lapstun '045 appear to suggest using biometrics stored in a backend application user record, do not teach or suggest storing biometric metadata on the document.

Regarding claim 13, Applicants respectfully submit that Lapstun '045 does not teach or suggest deciding when to stop capturing metadata. The cited portions of Lapstun '045 appear to suggest the material as asserted by the Examiner (Fig. 21) and Applicants respectfully request clarification.

Regarding claim 15, Applicants respectfully submit that the cited references do not teach or suggest at least:

wherein the digital pen is utilized to facilitate storing the processed metadata in the dynamic read-write storage device.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to claims 1-3 and 5-17.

### **3. Allowable Subject Matter**

Applicants appreciate the indication that claim 4 represents allowable subject matter. Accordingly, Applicants have canceled claim 4 and rewritten the claim in independent form including the independent claim and all intervening claims as new

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claim 21. Furthermore, new claims 22-24 depend from claim 21 which has already been indicated as being allowable.

Accordingly, Applicants respectfully submit that claims 21-24 are in condition for allowance.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection and submit that the invention as presently claimed in claims 1-3, 5-17 and 21-24 is patentable and in condition for allowance.

#### **4. Conclusion Of Remarks**

For at least the reasons stated above, it is respectfully submitted that the claims of this application are in condition for allowance and early and favorable action thereon is requested.

If the Examiner believes that additional issues may be resolved by a telephone interview, the Examiner is respectfully urged to telephone the undersigned attorney for Applicant at (203) 924-3180.

#### **5. Authorization**

No fee is believed due with this Amendment other than that associated with the enclosed petition for extension of time to respond. However, the Commissioner is hereby authorized to charge any additional fees which may be required for the response or credit any overpayment to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-522.

In the event that an extension of time or additional extension of time is required to make this response timely filed, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely. The Commissioner is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-522.


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Respectfully submitted,



George M. Macdonald  
Reg. No. 39,284  
Attorney of Record  
Telephone (203) 924-3180

PITNEY BOWES INC.  
Intellectual Property and Technology Law Department  
35 Waterview Drive, P.O. Box 3000  
Shelton, CT 06484-8000

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10/3/06 Amendment